

REMARKS

In the Office Action, the Examiner indicated that claims 36-38 and 40-49 are pending in the application and the Examiner rejected all claims.

Request for Withdrawal of Premature Final Rejection

Applicant requests reconsideration of the finality of the present rejection. The Examiner indicates that the claim amendments submitted by applicant necessitated the new grounds of rejection. This is incorrect. The amendment to claim 36 is simply the inclusion of the limitations of previously-presented claim 39 and is thus substantively identical to claim 39. This amendment should not have been the basis for a new search. In the previous Office Action, the Examiner rejected claim 39 under 35 U.S.C. §102 based on Johnson et al. In the present Office Action, the Examiner rejected claim 36, which is substantively identical to claim 39, based on the combination of Johnson and Rouphael et al. Applicant has not been afforded an opportunity to rebut the assertions of the Examiner and thus, making of the rejection final is premature. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the finality of the Office Action.

The Present Invention

The present invention is a method for wireless communication between a personal digital assistant (PDA) and a host computer. A docking cradle is configured to facilitate the transmission/receipt of chat and email communications between the PDA and the host computer, using cordless spread spectrum radio technology. Cordless spread spectrum radio technology

requires no access to traditional wireless carriers such as cellular telephone service. Using the present invention, one or more PDAs can carry on email communications and/or chat communications with an email or chat program on the host computer, using the cordless spread spectrum radio technology provided by the specialized docking cradle.

U.S. Patent No. 6,556,826 to Johnson et al.

U.S. Patent No. 6,556,826 to Johnson et al. ("Johnson") teaches a communication interface system whereby a communication device includes interface capability for multiple devices. The communication interface of Johnson includes a docking interface, a wireless interface, a telephone interface, and a computer interface and devices such as a PDA, a telephone, and a computer system all are able to communicate with a network via the communication interface.

U.S. Patent No. 6,278,725 to Roupael et al.

U.S. Patent No. 6,278,725 to Roupael et al. teaches a Rake receiver having fingers. The Rake receiver includes frequency discriminators for automatic frequency control and a combiner. The Examiner relies upon Roupael for an alleged teaching of the use of spread spectrum technology in cellular and cordless communications systems.

U.S. Patent No. 6,119,179 to Whitridge et al.

U.S. Patent No. 6,119,179 to Whitridge et al. teaches a portable adaptor that provides non-repudiable telecommunications services to barcode reading hand-held computers and palm-top or table-type mobile computers. The Examiner relies upon Whitridge for an alleged teaching of the establishment of communication between a chat program and an email program on a host computer and a program on a portable communication device.

The §103 Rejections

On page 2 of the Office Action, the Examiner rejected claims 36-38, and 40-47 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,556,826 to Johnson et al. in view of U.S. Patent No. 6,278,725 to Rouphael et al. and on page 5 of the Office Action, the Examiner rejected claims 48 and 49 under 35 U.S.C. §103(a) as being unpatentable over Johnson et al. in view of Rouphael et al. and further in view of U.S. Patent No. 6,119,179 to Whitridge et al.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

MPEP 2143

The Examiner has not met this burden. The present invention allows a user of a portable device, such as a PDA, to communicate with a host computer via a cradle for the PDA or

communication device, that is, the PDA and the docking device are configured to be able to communicate with each other via cordless spread spectrum radio technology, a localized form of radio technology utilized by cordless phones (as distinct from cellular wireless technology). The cradle then facilitates the completion of the communication path to the host device using the wire connecting the cradle to the host device. This allows the user to communicate, on a local level, between the PDA and the host computer using both the wireless receiving and transmitting capability of the cradle and its wired receiving and transmitting capability. It should be understood that this localized communication is significantly different than the wireless communication, via cellular technology, that is typically used for communication between a PDA and a host computer.

Johnson teaches a communication interface system whereby a communication device includes interface capability for multiple devices. Johnson teaches both a PDA cradle and wireless interface (docking interface 302 and wireless interface 303 of Figure 3). The wireless interface 303 is the typical long-distance wireless interface used for connecting a PDA to a host computer, typically via cellular technology. The connection between the PDA and the host device is entirely wireless. Johnson also suggests the combining of the docking interface and the wireless interface into a single unit. However, this suggested combination, at best, merely teaches the use of the cradle (the docking interface) as a support vehicle or support structure for the wireless interface, that is, while there is structural coupling between the two elements, there is no operable coupling of the two elements. At no time (while the PDA is not in the docking interface) is the communication between the PDA and the host device facilitated by the wired connection between

the docking interface and the host device. They work independently of each other but are combined in a single structure for convenience.

The present invention specifically recites the requirement that the communication of a signal between the host computer and the portable communication device occurs through the docking device, and that such communication uses cordless spread spectrum radio technology. The Examiner admits that Johnson does not teach the use of cordless spread spectrum technology as a means for communicating between a PDA and a host device via a docking device.

The addition of Rouphael does not provide the necessary teaching, nor suggestion, to support the rejection made by the Examiner. The portion of Rouphael relied upon by the Examiner for this alleged teaching and suggestion is as follows:

“Illustratively, the Rake receiver 200 is used for wireless telephones or handsets with code division multiple access (CDMA) modulation, such as cellular CDMA phones or cordless spread spectrum phones.” Rouphael, column 7, lines 11-14.

This is clearly not a teaching or suggestion of using cordless spread spectrum technology to communicate locally between a handheld device and a host computer via a cradle that is also usable for holding the handheld device. Without any teaching or suggestion of a motivation to combine the references as suggested by the Examiner, the combination is improper for use as a rejection under 35 U.S.C. §103. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 36-38 and 40-47 under 35 U.S.C. § 103.

The addition of Whitridge et al. does not render claims 48 and 49 unpatentable. As noted above, neither Johnson nor Rouphael teach the ability to provide localized communication between a handheld device and a host computer via a cradle designed to hold the handheld device, nor do

they teach or suggest such communication using cordless spread spectrum technology. The Examiner relies on Whitridge for an asserted teaching of the establishment of a communication between a chat program and/or an email program on a host computer and a chat program and/or email program on a portable communication device. Applicant does not claim to have invented the use of handheld devices for conducting chat or email communications. However, nothing in Whitridge teaches or suggests the use of cordless spread spectrum radio technology to provide localized communication, including chat or email, between a handheld device and a host computer via a cradle designed for holding the handheld device. Thus, the rejection of claims 48 and 49 based on the combination of Johnson, Roupheal and Whitridge is inappropriate and should be withdrawn. The Examiner is respectfully requested to reconsider and withdraw the rejection of claims 48 and 49 under 35 U.S.C. § 103.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.


PATENT
Application No. 09/772,455

Docket No. RSW920000148US1
Page 8

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted

June 23, 2004
Date


Mark D. Simpson, Esquire
Registration No. 32,942

SYNNESTVEDT & LECHNER LLP
2600 ARAMARK Tower
1101 Market Street
Philadelphia, PA 19107

Telephone: (215) 923-4466
Facsimile: (215) 923-2189

M:\MSimpson\Clients\IBM Raleigh RSW\24456 USA\Patent Office\reply to final action of 04232004.wpd